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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,269	02/06/2004	Yury Shkolnikov	14227	8668

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EXAMINER

TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/774,269	Applicant(s) SHKOLNIKOV ET AL.	
	Examiner Thanh K Truong	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on December 13, 2004.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagdy (4,483,473).

Wagdy discloses an apparatus comprising:

a cylinder body 29;

a reciprocating probe assembly 20, 30, 50 slidably mounted to the cylinder body between a first, extended position and a second, retracted position, the probe assembly and configured for contacting a workpiece; and

at least one shock-absorbing member 40 operationally associated with at least one of the cylinder body and probe assembly for reducing shock load generated during operation of the tool (column 3, lines 65-67); and

a single spring 57 disposed between the lower end of the probe assembly and a retaining ring (the retaining 56 is the end member that support the end of the spring 57

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under the cylinder 29) and configured for biasing the probe assembly into the first position (as in claim 17).

4. Claims 1-11 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nayrac et al. (6,138,887).

Nayrac discloses an apparatus comprising:

a cylinder body (5);

a reciprocating probe assembly (6) slidably disposed relative to the cylinder body between a first, extended position and a second, retracted position, the probe assembly and configured for contacting a workpiece; and

at least one shock-absorbing member (18, 35, 36) operationally associated with at least one of the cylinder body and the probe assembly for reducing shock load generated by the tool during combustion and transmitted between the probe assembly and the cylinder body.

Nayrac further discloses: the probe assembly includes at least one arm portion (20, 21) configured for sliding relationship relative to the cylinder body, the at least one shock-absorbing element (35, 36) disposed between the upper end (37, 38) and a corresponding element of the cylinder body 5 for transmitting loads from the probe assembly to the cylinder body - as in claim 2 (column 4, lines 60-63);

a substantially perpendicular lip at an upper end for contacting the at least one shock-absorbing element – as in claim 3 (figures 2 & 4);

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the cylinder body defines a track for the slidable relative movement of the probe assembly, and the at least one shock-absorbing member is configured for slidable movement in the track – as in claim 4 (as the springs 35, 36 compressed and expanded in the track, any element of the spring between the two ends are sliding in the track);

at least one tab 37, 38 for defining an upper limit of movement of the probe assembly; at least one shock-absorbing member is configured for common travel with the probe assembly to the tab – as in claims 5 & 6 (figures 2 & 4); shock-absorbing member is sliding freely on the track and is secured to one of the probe assembly and the tab – as in claims 7 & 8; shock-absorbing member is configured to be substantially complementary with the path; and is generally cylindrical in shape – as in claims 9-11; and the probe assembly includes an upper end, and the at least one shock absorbing member (35) is disposed between the upper end of the probe assembly and an associated portion of the cylinder body – as in claim 20.

5. Claims 1, 12-15, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nikolich (5,197,646).

Nikolich discloses an apparatus comprising:

a cylinder body 30;

a reciprocating probe assembly 80, 40 slidably mounted to the cylinder body between a first, extended position and a second, retracted position, the probe assembly and configured for contacting a workpiece; and

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at least one shock-absorbing member 76 operationally associated with at least one of the cylinder body and probe assembly for reducing shock load generated during operation of the tool; and

Nikolich further discloses (figures 8 & 9):

a cylinder body 204;

a reciprocating probe assembly 220 slidably mounted to the cylinder body between a first, extended position (figure 10) and a second, retracted position (figure 9), the probe assembly and configured for contacting a workpiece;

the at least one shock-absorbing member 76 is configured for reducing load forces generated in a combustion chamber of the assembly upon the probe assembly reaching the second position, and being configured to have sufficient rigidity to limit the travel of the probe assembly relative to the cylinder body and also sufficient resilience for absorbing shock forces generated by the tool in the second position – as in claim 12;

the probe assembly further includes a lower end, a single spring 230 disposed between the lower end of the probe assembly 220 and the cylinder body 204 and retaining ring 216 and configured for biasing the probe assembly into the first position (as in claims 12 & 17); the single spring is a conical spring – as in claims 14 & 18 (figure 8); and one end of the spring is seated on the retaining ring – as in claim 15 (figure 8).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nikolich (5,197,646).

As discussed above in paragraph 5 of this office action, Nikolich discloses the claimed invention, in which the larger diameter of the conical spring is mounted to the end of the cylinder body 204 and the smaller diameter end is mounted to the retaining ring which is connected to the probe assembly 220.

Applicant's conical spring larger diameter end mounted to retaining ring (which connected to the cylinder body) and a smaller diameter end is mounted to the probe assembly (as recited in claims 16 and 19). However, it appears that Nikolich's arrangement of the conical spring would perform equally well. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to use the conical spring arrangement as taught by Nikolich's to provide a biasing force between the retaining ring and the lower end of the probe assembly. Accordingly, the conical spring arrangement of the Applicant is deemed to be a design consideration which fails to patentably distinguish over the prior art of Nikolich.

Response to Arguments

8. Applicant's arguments filed December 13, 2004 have been fully considered but they are not persuasive.

In response to the Applicant's argument with respect to claims 1 & 17 (as being anticipated by Wagdy '473), that the present invention (claim 1) includes a shock-absorbing member that is located on the outside of a cylinder body, it is noted that the feature upon which applicant relies is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Regarding to claim 17, as discussed above in paragraph 3 of this office action, a single spring 57 disposed between the lower end of the probe assembly and a retaining ring (the retaining 56 is the end member that support the end of the spring 57 under the cylinder 29), and configured for biasing the probe assembly into the first position.

Applicant's arguments with respect to claims 1-11 (as being anticipated by Nikolich '646) have been considered but are moot in view of the new ground(s) of rejection.

In response to the Applicant's argument that "the examiner mistakenly construed figures 8-10 as being part of the invention disclosed in Nikolick", and "Therefore, the spring 230 in FIGs. 8 and 9 is not a component of the Nikolich invention. In fact, Nikolich teaches away...". The examiner disagrees. "A patents are relevant as prior art for all they contain" (MPEP 2123); event the nonpreferred embodiments.

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

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A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K Truong whose telephone number is (571) 272-4472. The examiner can normally be reached on Mon-Thurs from 8:00 AM to 6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tkt

March 5, 2005.



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700